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U.S. Patent & TMOfc/TM Mail Rcpt Dt. #30

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARDPETITION FOR CANCELLATION

In the Matter of Registration No. 2,579,470

Dated on June 11, 2002 for VIRGIN LAKE SOFTWARE.

VIRGIN ENTERPRISES LIMITED,

Petitioner,

v.

MICRO COMPUTER SOLUTIONS, INC. d/b/a
VIRGIN LAKE SOFTWARE

Registrant.

Cancellation No.

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TO THE COMMISSIONER OF PATENTS AND TRADEMARKS:

VIRGIN ENTERPRISES LIMITED ("VEL" or "Petitioner"), a company organized and existing under the laws of England and Wales with its principal place of business at 120 Campden Hill Road, London W8 7AR, England, believes that it is or will be damaged by the continued presence on the Principal Register of Registration No. 2,579,470, dated June 11, 2002, of the service mark VIRGIN LAKE SOFTWARE for "providing installation of computer software; maintenance services relating to computer software, namely, troubleshooting of

CERTIFICATION UNDER 37 C.F.R. 1.10

I hereby certify that this paper is being deposited with the United States Postal Service as Express Mail, Label No. in the envelope addressed to: Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513, on February 28, 2003.

Gianni P. Servodidio
(Name) (Signature)2/28/03
(Date of Signature)

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computer software problems via telephone and email; and consultation services in the field of computer software”, and hereby petitions to cancel same.

As grounds of cancellation, it is alleged that:

1. Petitioner, VEL, and its related companies (collectively, the “Virgin Group”), conduct numerous worldwide businesses under the trade name, trademark, and service mark VIRGIN. In the year ending December 31, 1999, Virgin Group companies employed more than 25,000 staff in twenty-six (26) countries and had worldwide sales revenues in excess of U.S. \$5 billion. A description of Virgin Group company operations appears at the Internet web site associated with the domain name www.virgin.com, copies of which are annexed hereto as Exhibit 1.

2. VEL’s licensee, Virgin Interactive Entertainment Plc, has engaged in the design, development, manufacture, distribution and sale of VIRGIN branded computer software products in U.S. commerce since at least as early as 1994. Color copies of photographs of VIRGIN branded software products are annexed hereto as Exhibit 2.

3. VEL’s licensee, Virgin Entertainment Group, Inc., has operated VIRGIN and VIRGIN MEGASTORE retail stores in U.S. commerce since at least as early as 1992. VEL’s VIRGIN and VIRGIN MEGASTORE retail stores offer a wide variety of computer related products and services including without limitation computer game software, computer accessories, wireless telecommunication services and computer hardware as well as CDs, audio tapes, and books. A description of the VIRGIN MEGASTORE services can be found at the Internet web site associated with the domain name www.virginmegamagazine.com, copies of which are annexed hereto as Exhibit 3.

4. VEL's licensee, Virgin Net Limited, has offered VIRGIN and VIRGIN NET Internet information services in U.S. commerce since at least as early as 1996. A current description of VIRGIN NET services can be viewed at the web site associated with the domain name www.virgin.net, copies of which are annexed hereto as Exhibit 4.

5. Additional VIRGIN branded products and services offered in U.S. commerce under license from VEL since prior to the September 1999 date of first use claimed by Registrant include, without limitation, electronic mail services, providing networks for the transmission and receipt of electronic mail, and providing an online shopping mall via the Internet, among many others.

6. By reason of more than thirty (30) years of continuous and substantially exclusive use as well as Virgin Groups companies' expenditure of tens of millions of dollars on advertising and promotion, Petitioner's VIRGIN mark has come to be famous and to symbolize extensive goodwill identifying Virgin Group companies and their founder, Sir Richard C.N. Branson. In 1997, Interbrand identified VIRGIN as one of The World's Top 100 Brands, ranking in a tie with CANON, ranked just below KLEENEX.

7. Petitioner is the owner of numerous trademark and service mark registrations in the U.S. Patent and Trademark Office comprising the word VIRGIN including:

- (a) U.S. Registration No. 1,851,817 for VIRGIN for, *inter alia*, "retail store services in the fields of computers and electronic apparatus; games";
- (b) U.S. Registration No. 1,852,776 for VIRGIN (stylized) for, *inter alia*, "retail store services in the fields of computers and electronic apparatus; games"; and

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- (c) U.S. Registration No. 2,625,455 for VIRGIN for, “providing an on-line shopping mall via a global computer network; providing business information via a global computer network”; “computerized communication services, namely, electronic mail services, and providing networks for the purposes of transmission and reception of computer generated music, news and other data and information; and broadcasting services by radio and over a global computer network of a wide variety of programs, namely, current events, economics, politics, sports, entertainment, the arts and business”.

8. Petitioner has pending at the U.S. Patent and Trademark Office, the following applications incorporating its famous VIRGIN mark covering goods and/or services related to the computer and software industries:

- (a) U.S. Application Serial No. 74/581,589 for VIRGIN (stylized) for, *inter alia*, “graphical interface to aid the delivery of interactive products and services by cable or wireless transmissions; computer game software; computer software for educational computer games; computer software for global computer network access; computer hardware”; and
- (b) U.S. Application Serial No. 75/979,112 for VIRGIN (stylized) for, *inter alia*, “video game programs; video game cartridges; electronic transmission and display of information for business or domestic purposes from a computer stored data bank; retail store services in the fields of computers and electronic apparatus, games, and video game cartridges.”

9. Since long prior to September 1999, the alleged date of first use for VIRGIN LAKE SOFTWARE, Petitioner has used VIRGIN as a mark on or in connection with a wide variety of products and services including computer software and related services.

10. Registrant obtained a registration in the United States Patent and trademark Office, Registration No. 2,579,470, dated June 11, 2002, of the designation VIRGIN LAKE SOFTWARE for “providing installation of computer software; maintenance services relating to computer software, namely, troubleshooting of computer software problems via telephone and email; and consultation services in the field of computer software.”

11. Registrant's designation VIRGIN LAKE SOFTWARE so resembles Petitioner's VIRGIN name and mark as to be likely, when applied to Registrant's services, to cause confusion and mistake and to deceive, with consequent injury to Petitioner, the trade and the public.

12. Registrant's designation VIRGIN LAKE SOFTWARE is likely to cause dilution of the distinctive quality of Petitioner's famous VIRGIN name and mark.

13. Petitioner believes it is and will continue to be damaged by Registrant's unrestricted registration for VIRGIN LAKE SOFTWARE because it will support and assist Registrant in the confusing and misleading use of Registrant's designation VIRGIN LAKE SOFTWARE and because such registration creates unrestricted statutory rights in Registrant, in violation and derogation of the prior and superior rights of Petitioner.

WHEREFORE, Petitioner prays that U.S. Reg. No. 2,579,470 for the similar mark VIRGIN LAKE SOFTWARE be cancelled.

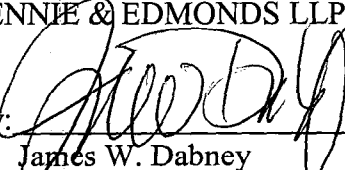
Please recognize as attorneys for Petitioner in this proceeding, James W. Dabney, Gianni P. Servodidio, Joyce Ferraro, and Melissa A. Antonecchia (members of the Bar of the State of New York), and the law firm of Pennie & Edmonds LLP, 1155 Avenue of the Americas, New York, New York 10036.

Please address all communications to James W. Dabney, Esq. at the above
address.

Dated: February 28, 2003

Respectfully submitted,

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